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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,551	03/29/2004	Claudio Bucolo	P03491	3392
23702 7590 01/26/2009 Bausch & Lomb Incorporated One Bausch & Lomb Place Rochester, NY 14604-2701				
EXAMINER				
PACKARD, BENJAMIN J				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
01/26/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,551

Applicant(s)

BUCOLO ET AL.

Examiner

Benjamin Packard

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1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1.6-11, 15-17, 20, 22, 25-28 and 47 is/are pending in the application.
- 4a) Of the above claim(s) 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1.6-11, 20, 22, 25-28 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

Applicants' arguments, filed 11/04/08, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 103

Claims 1, 6-11, 25-28, and 47 were rejected under 35 U.S.C. 103(a) as being unpatentable over Singh et al (US Pregrant Pub 2003/0232089, see IDS dated 06/24/2004) in view of Olejnik et al (US 5,597,599) and Gohzu et al (US 5,013,445).

This rejection is maintained.

Applicants assert there is no motivation to substitute the various gum compounds, specifically asserting the unexpected advantages suggested in Singh et al appear to be directed to combinations of nonionic and anionic gums. Further, Applicants assert the secondary references do not provide additional guidance over Singh et al alone.

Where the specific combination of features claimed is disclosed within the broad generic ranges taught by the reference but such "picking and choosing" within several variables does not necessarily give rise to anticipation. *Coming Glass Works v. Sumitomo Elec.*, 868 F.2d 1251, 1262 (Fed. Circ. 1989). Where,

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as here, the reference does not provide any motivation to select this specific combination of variables, anticipation cannot be found.

That being said, however, it must be remembered that “[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious”. KSR v. Teleflex, 127 S.Ct. 1727, 1740 (2007)(quoting Sakraida v. A.G. Pro, 425 U.S. 273, 282 (1976)). “[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious”, the relevant question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” (Id.). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” KSR v. Teleflex, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that “[a] person of ordinary skill is... a person of ordinary creativity, not an automaton.” Id. at 1742.

Consistent with this reasoning, it would have obvious to have selected various combinations of gums from within a prior art disclosure, to arrive compositions “yielding no more than one would expect from such an arrangement”. Note, while Applicants assert Singh et al teaches towards the benefits of anionic and nonionic gum combinations, Examiner uses the broader teaching that various gums may be used together. The motivation to select the

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instantly claimed "gums" comes from the fact that Singh et al discloses the exact compounds in their list of alternatives, thus leading one of ordinary skill in the art to pick and choose from among the group to yield no more than what would be expected, i.e., a viscoelastic composition.

Olejnik et al was simply cited to evidence mannitol and sorbitol are known tonicity adjusting agents, which one of ordinary skill in the art, when reading the need for a tonicity adjusting agent in Singh et al, would find obvious to use, given the compound is used for its known purpose..

Similarly, Gohzu et al was simply cited to evidence the amount of tris-hydroxymethylamino methane generally used to achieve the proper pH, which provides motivation to adjust the molar amount to within the instantly claimed range.

Therefore, as previously argued, it would have been obvious to pick and choose among the gums and other additives to result the viscoelastic composition instantly claimed.

Claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over Singh et al (US Pregrant Pub 2003/0232089) in view of Olejnik et al (US 5,597,599) and Gohzu et al (US 5,013,445), further in view of Cantoro et al (US 5,770,628).

This rejection is maintained.

This rejection was not addressed by Applicant.

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Claim 22 was rejected under 35 U.S.C. 103(a) as being unpatentable over Singh et al (US Pregrant Pub 2003/0232089) in view of Olejnik et al (US 5,597,599) and Gohzu et al (US 5,013,445), further in view of Katz (US 4,287,175).

This rejection is maintained.

This rejection was not addressed by Applicant.

Conclusion

No claims allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Packard whose telephone number is 571-270-3440. The examiner can normally be reached on M-R 8-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin Packard/
Examiner, Art Unit 1612

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612